

REMARKS

Applicant files these Remarks in response to the Office's statement of reasons for allowance, appended to the Notice of Allowability mailed on December 28, 2005. It is respectfully requested that the Office issue a new statement of reasons for allowance to correct for the record the Office's interpretation of claim 20 in the present application.

The Reasons for Allowance is stated as follows:

In use of the terminology, "means for attaching said desk pad to said extension portion", claim 20 clearly invokes the provisions of 112, 6th paragraph. The definition for the attaching means is clearly found in paragraph [0017] of the specification, and reinforced on page 2 lines 19-21, and figures 1, 2, 3, 3A, 4 and 6. *At no point in the original disclosure is the attaching means provided on any other location but the extension portion.* Therefore, notwithstanding arguments of counsel, *the original specification clearly defines the attaching means as being located on the extension portion.* Accordingly, it is the examiner's opinion that the prior art neither discloses, nor fairly suggests, a desk pad organizer tray formed from a plurality of superimposed board members with an extension portion and attaching means as arranged and claimed by the application.

The claim language referred to in the Reasons for Allowance is as follows:

means for attaching said desk pad to said extension portion, adjacent to said tray portion.

Applicant concedes that this language invokes 112, 6th paragraph. However, Applicant respectfully submits that the *location* of the claimed "means for attaching" is not part of the structure performing the claimed function. The function is, "attaching said desk pad to said extension portion." The location of the means for performing this function is irrelevant to carrying out the function, except that it might be on the extension portion or on the desk pad.

The case law fully supports Applicant's position: Consider *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 42 U.S.P.Q.2d 1777 (Fed. Cir. 1997), in which the patent in suit claimed an apparatus for removing water vapor from a sample (i.e., an analyte slug) to be analyzed in a gas chromatograph. The means plus function clause reads:

first means for passing the analyte slug through a *passage* heated to a first temperature higher than ambient, as the analyte slug passes from the sparge vessel to the trap ...

The district court held that the term *passage* was to be construed by comparing the passage configuration shown in the specification to the passage in the accused device. The Federal Circuit disagreed with the district court, holding that the term *passage*, though appearing within the means plus function clause, is not the part of the structure performing the claimed function. 115 F. 3d at 1581, 42 U.S.P.Q.2d at 1780. In this regard, the Federal Circuit stated:

Although the passage may act upon the slug by channeling it while it is being passed, it is not the means that causes the passing. Rather, it is the place where the function occurs, not the structure that accomplishes it. Thus, although claim 17 is a means plus function claim subject to section 112, Para. 6, it is not so in respect of the word "passage."

Id.

Also consider *BBA Nonwoven Simpsonville, Inc. v. Supperior Nonwovens, LLC*, 303 F. 3d 1332, 1343-44, 64 U.S.P.Q.2d 1257, 1266 (Fed. Cir. 2002), in which the patent claimed an apparatus for manufacturing spunbond nonwoven fabric. One of the claimed limitations reads:

d) corona means cooperating with said attenuator and positioned for electrostatically charging the filaments so that repelling forces are induced in the filaments to more uniformly spread the filaments

The accused infringer argued that, notwithstanding the broad positioning language in this claim element, the corona means was required to be in a location limited to the position of the disclosed corona means because the positioning language was part of the functional description that limited coverage of the claim language to equivalents of the structure shown in the specification. The Federal Circuit disagreed, finding that the functional language of this means plus function element ended with the word "attenuator," and the positioning language was locational language that would be construed and applied outside of the special rules of means plus function clauses. The Court noted, "What the 'corona means' is and where it is located are two different things." *Id.*

Thus, in the present application, the location of the "means for attaching" is not part of the section 112, 6th par. analysis. Traditional interpretation rules apply. Since the location of the "means for attaching" is not specified in claim 20, claim 20 should not be construed to require the attachment means to be located only on the extension portion.

Assuming, *arguendo*, that the location is part of the means plus function clause in claim 20, claim 20 should *not* be construed to be limited only to the location shown in specification. To do so would nullify the provisions of section 112, 6th par., requiring that the limitation shall be construed to cover the structure described in the specification and equivalents thereof. *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1574, 225 U.S.P.Q. 236, 238 (Fed. Cir. 1985); MPEP § 2184 (August 2005).

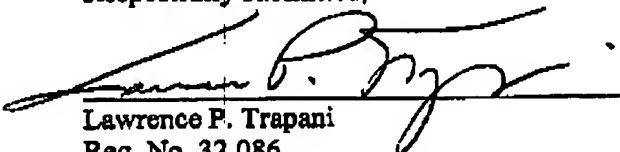
In paragraph [0017] of the specification of the present application, the location of the "means for attaching" is described as follows: "As shown, attachment element 15 is *preferably* applied to extension member 14 . . ." (Emphasis added.) By its very language, the specification does not foreclose the possibility of alternative and equivalent locations. It is *preferably* located, not exclusively located, on the extension member. It is beyond question that an equivalent location would be on the other member being joined by the "means for attaching" (i.e., the desk pad).

In view of the above arguments, it is respectfully submitted that claim 20 should not be construed to require the attachment means to be only located on the extension portion. Thus, it is respectfully requested that the Office issue a new Reasons for Allowance expressly accepting Applicant's interpretation of claim 20.

Early and favorable reconsideration of the application is most earnestly solicited. If for any reason the Examiner feels that consultation with Applicant's attorney will be helpful, he is invited to call Applicants' attorney.

Respectfully submitted,

1-9-06
Date



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